



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,431	04/03/2001	Stuart D. Baker	209.1001	2071

7590 07/13/2005

DAVIDSON, DAVIDSON & KAPPEL, LLC  
485 Seventh Avenue, 14th Floor  
New York, NY 10018

EXAMINER

NGUYEN BA, PAUL H

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/825,431

Applicant(s)

BAKER ET AL.

Examiner

Paul Nguyen-Ba

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27, 41-59, 71 and 72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27, 41-59, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/25/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/13/01, 6/10/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Notice to Applicant*

1. This action is responsive to Applicant's Response to Election/Restriction filed on April 25, 2005.
2. Claims 1-27, 41-59, 71 and 72 are currently pending. Claims 1, 18, 41, 49, 57, 71, and 72 are independent claims.

### *Claim Objections*

3. Claims 42-48 are objected to because of the following informalities: Dependent claims 42-48 are dependent upon a non-existent independent claim 41. Appropriate correction is required.

**Examiner Note:** The instant application was examined under the assumption that Applicant inadvertently cancelled independent claim 41 instead of the non-elected dependent claim 40. To expedite a complete examination of the instant application claim 41 is rejected as set forth below in anticipation of applicant amending these claims to place them within proper standing. It follows that dependent claim 40 is not considered pending in the instant application.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2176

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 9, 10, 12-15, 17, 18, 21-26, 49, 50, 53-59, 71 and 72 are rejected under 35 U.S.C. 102(e) as being anticipated by Dickinson, III et al. ("Dickinson"), U.S. Patent Application Publication No. 2003/0196098.

**Regarding claims 1, 18, 49, 71 and 72,** Dickinson discloses a digital communication system to denote confidentiality of a digital communication comprising (see Abstract and Summary):

*a processor and a memory containing a program executable by the processor to* (see para [0018] → system takes the form of a program executing on a conventional general purpose computer):

*attach a privileged attribute to a digital communication* (see paras [0030-0031] → a policy module (*compare with "attribute"*) can be set or attached to an e-mail to require either encryption, signature, or both, to enforce attorney-client privilege);

*create a privileged distribution list of at least one intended recipient* (see paras [0022-0023] → i.e. recipient policy list);

*restrict access to the privileged digital communication to the at least one intended recipient* (see paras [0009], [0024] and [0030-0031]);

*restrict routing of the privileged digital communication to the at least one intended recipient* (see paras [0009], [0024] and [0030-0031]) and,

*store the privileged digital communication in a segregated location on a data storage device (see paras [0010] and [0040-0041] → messages may be stored at specific segregated destinations or queues).*

**Regarding claim 2**, Dickinson discloses *wherein the at least one intended recipient is a plurality of intended recipients* (see para [0031] → policies can be applied to users, either individually or by groupings).

**Regarding claim 3**, Dickinson discloses:

*a mail server* (see para [0034]);

*a segregated server housing the segregated location* (see paras [0034-0038]);

*wherein the program is further executable to send a copy of the communication to the segregated server* (see paras [0010], [0034-0038], and [0040-0041]).

**Regarding claims 6, 50, 57, and 58**, Dickinson discloses *configuring access rights to the digital communication when the document is opened and to enforce said access rights by managing access to the digital communication and controlling the manipulation of its contents* (see paras [0009], [0024] and [0030-0031]).

**Regarding claims 9, 21, and 54**, Dickinson discloses *executing automatically and attaching the privileged attribute to particular communications according to predetermined selection criteria* (see para [0022-0031]).

**Regarding claims 10, 22, and 55**, Dickinson discloses *a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication* (see para [0039] → i.e. notification actions).

**Regarding claims 12, 23, 56, and 59**, Dickinson discloses the system *wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met* (see Abstract and para [0007] *et seq.*).

**Regarding claims 13 and 24**, Dickinson discloses a *server object and a client object* (see paras [0034-0037]).

**Claims 14, 15, 17, 25, 26, and 53**, incorporate substantially similar subject matter as independent claim 1 and are rejected along the same rationale.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5, 7, 8, 11, 16, 19, 20, 27, 41-48, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson, III et al. ("Dickinson"), U.S. Patent Application Publication No. 2003/0196098.

**Regarding claims 4, 5, 7, 8, 19, 20, 41, 42, 46, 47, 51, and 52,** Dickinson discloses a communication system (i.e. e-mail) containing a plurality of user specified information fields, such as source field specifying an e-mail address for the source of the message, a destination field specifying one or more destination e-mail addresses for the message, a subject field specifying a subject for the message, a body field specifying the body of the message containing textual and/or graphics data, and an optional attachment field, specifying one or more files to be transmitted with the message. Other user specified fields include, but are not limited to, priority of the message, identity of the sending agent, and the date and time of the message (see para [0019]).

Dickinson does not explicitly disclose sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location.

However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include sending a copy as a blind carbon copy, a characteristic including a department of a corporation using the system, forwarding of the communication, and copying and cutting contents into another location (e.g. Microsoft Outlook, Hotmail, Yahoo! Mail, etc.) for the

Art Unit: 2176

motivational purpose of comprising the major common functional components of a user friendly e-mail system.

**Regarding claim 11**, Dickinson does not explicitly teach acknowledging a confidentiality notice by clicking on a GUI button. However, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include clicking on a GUI button for the motivational purpose acknowledging a pop-up window (*compare with* “confidentiality notice”).

**Regarding claims 16 and 27**, Dickinson does not explicitly teach that the client object is a plug-in to a pre-existing communication system. However, Dickinson discloses the S/MIME protocol to exchange secure e-mail messages (see para [0034]). It is well known to a skilled artisan that most plug-in modules (e.g. Navigator) are based on MIME file types that simply plugs in to the existing system.

Therefore, it was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to include a plug-in to a pre-existing communication system for the motivational purpose of adding a specific feature or service to a larger system.

**Regarding claim 43**, Dickinson discloses *executing automatically and attaching the privileged attribute to particular communications according to predetermined selection criteria* (see para [0022-0031]).



**Regarding claims 44**, Dickinson discloses *a confidentiality notice that is displayed to a user and acknowledged by the user before displaying the privileged communication* (see para [0039] → i.e. notification actions).

**Regarding claims 45**, Dickinson discloses the system *wherein the privileged digital communication is encrypted and decryption methods if a predetermined condition is met* (see Abstract and para [0007] *et seq.*).

**Claim 48** incorporates substantially similar subject matter as independent claim 1 and is rejected along the same rationale.

### ***Conclusion***

8. The prior art made of record on form PT0-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

Art Unit: 2176

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094.

The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
7/10/2005